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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MATHEW, FENN C

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,279

Applicant(s)

ISH, A. BUELL

Examiner

Fenn Mathew

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 20-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

gem

I. Claims 1-²³~~19~~ and 36-41, drawn to a pad assembly and method for use, classified in class 482, subclass 139.

gem

II. Claims ²⁴~~20~~-35, drawn to an exercise device containing a pad assembly, classified in class 482, subclass 92.

2. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the exercise device does not need the pad assembly as claimed. The subcombination has separate utility such as a support for non-exercise related devices such as crutches.

3. During a telephone conversation with Mr. Dale Barr on September 6, 2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-23 and 36-41. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Voris (U.S. Patent No. 4,357,011). Voris discloses a pad assembly (22) for an exercise machine comprising a compressible layer (64) having a first surface adapted to engage a portion of a user's body and a second surface opposite from the first surface (see fig. 6), and a backing member (52) having a non-planar surface engaged with the second surface of the compressible layer.

6. Referring to claim 2, Voris further discloses the backing member comprising a contoured support attached to the second surface.

7. Referring to claim 3, Voris discloses the device wherein the non-planar surface comprises a contoured portion that provides a compressed shape of the compressible layer that approximately corresponds with an anticipated shape of the portion of the user's body.

8. Referring to claim 5, Voris discloses a device wherein the first surface comprises a concave portion adapted to engage a portion of the user's body.

9. Referring to claim 6, Voris discloses a device wherein the non-planar surface of the backing member is shaped to provide an approximately uniform-thickness portion of

the compressible layer when a compression force is applied to the first surface during an exercise.

10. Referring to claim 7, Voris discloses a device wherein the approximately uniform-thickness portion is co-extensive with a portion of the first surface adapted to engage the portion of the user's body.

11. Referring to claim 8, Voris discloses a device wherein the non-planar surface of the backing member is shaped to provide an approximately uniform-pressure portion when a compression force is applied to the first surface during an exercise. (Column 5, lines 5-10).

12. Referring to claim 9, Voris discloses a device wherein the backing member comprises a coupling assembly adapted to attach to an exercise machine.

13. Referring to claim 10, Voris discloses a device wherein the backing member comprises a contoured backing plate.

14. Referring to claim 11, Voris discloses a device wherein the backing member comprises an axisymmetric member. (See figs. 6, 7).

15. Claims 12-15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Voris (U.S. Patent No. 4,357,011). Voris discloses a pad assembly (22) for an exercise machine comprising a compressible layer (64) having a first surface adapted to engage a portion of a user's body and a second surface opposite from the first surface (see fig. 6), the second surface being adapted to engage a contoured backing surface such that a compression force applied to the first surface provides an approximately uniform-

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thickness portion of the compressible member between the first surface and the contoured backing surface.

16. Referring to claim 13, Voris further discloses the second surface comprising a depressed portion adapted to fittingly engage at least a portion of the contoured backing surface.

17. Referring to claim 14, Voris discloses the contoured backing surface comprising a contoured pad support projecting from a moveable portion of the exercise machine.

18. Referring to claim 15, Voris discloses the approximately uniform-thickness portion being co-extensive with a portion of the first surface adapted to contact the portion of the user's body.

19. Referring to claim 18, Voris discloses pad assembly wherein when the compressible force is applied the compressible member provides a first surface that approximately corresponds with an anticipated shape of the portion of the user's body.


20. Claims 19-21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Voris (U.S. Patent No. 4,357,011). Voris discloses a pad assembly (22) for an exercise machine comprising a layer of compressible padding (64) having a first surface adapted to engage a portion of a user's body and a second surface opposite from the first surface (see fig. 6), a backing structure attached to the layer of compressible padding and having a backing surface proximate the second surface (see fig. 6), the backing surface being shaped to provide an approximately uniform-thickness portion of the layer of compressible padding when a compression force is applied to the first surface.

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21. Referring to claim 20, Voris discloses the backing surface being contoured such that the compression force is approximately uniformly distributed over the first surface.

22. Referring to claim 21, Voris discloses the pad assembly wherein the approximately uniform-thickness portion is co-extensive with the first surface.

23. Referring to claim 23, Voris discloses the pad assembly wherein the backing structure comprises a channel attached to the backing structure opposite from the layer of compressible padding and adapted to attach to a support portion of an exercise machine.

 24. ³⁹Claims 36-~~38~~ and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Voris (U.S. Patent No. 4,357,011). Voris discloses a method of exercising comprising providing a compressible layer having a first surface, and a backing structure having a non-planar backing surface engaged against the compressible layer opposite the first surface, and pressing a portion of a user's body against the first surface to compress the compressible layer between the portion of the user's body and the non-planar backing surface and to form an approximately uniform-thickness portion of the compressible layer therebetween.

25. Referring to claim 37, Voris discloses the method wherein pressing a portion of a user's body against the surface to compress the compressible layer comprises pressing a portion of a user's body against the first surface to form an approximately uniform-thickness portion of the compressible layer that is co-extensive with the portion of the user's body.

26. Referring to claim 38, Voris discloses the method wherein pressing a portion of a user's body against the first surface to compress the compressible layer comprises pressing a portion of a user's body against the first surface to form an approximately uniform-pressure distribution on the portion of the user's body.

27. Referring to claim 39, Voris discloses the method wherein pressing a portion of a user's body against the first surface to compress the compressible layer comprises pressing a portion of a user's leg against the first surface. (See fig. 2a)

28. Referring to claim 41, Voris discloses the method wherein pressing a portion of a user's body against the first surface to compress the compressible layer comprises pressing a portion of the user's shoulder against the first surface.

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 4, 16-17, 22, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voris (U.S. Patent No. 4,357,011).

31. Referring to claims 4, 16, and 22, Voris has disclosed the claimed invention (see above) except for the exact range of the radius of curvature of the contoured portion. The feature of having the radius of curvature of the contoured portion fall within the range of 1.5 inches to 7.0 inches is a matter of design choice, wherein no stated

problem is solved nor any unexpected result is attained by the radius of curvature of the pad assembly disclosed by Voris.

32. Referring to claim 17, Voris discloses the claimed invention except for the use of polyurethane. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the compressible member made of polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

33. Referring to claim 40, Voris discloses the method wherein pressing a portion of a user's body against the first surface to compress the compressible layer comprises a portion of a user's shoulder (fig. 1) or leg (fig. 2). The structure as claimed is capable of allowing a user to press any portion of their body against the compressible layer. The feature of pressing a user's arm against the compressible first layer would have been obvious to one having ordinary skill in the art in order to perform exercises involving the arms of a user.

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Winslow et al. U.S. Patent No. 5,336,152

Rehrl et al. U.S. Patent No. 4,725,056

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fenn Mathew whose telephone number is (703) 305-2846. The examiner can normally be reached on Monday - Friday 9:00am - 5:30pm.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

fcm
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September 8, 2002


S. THOMAS HUGHES
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